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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/732,498
Filing Date: December 06, 2000
Appellant(s): FOOTER ET AL.

MAILED

FEB 22 2006

Technology Center 2600

Footer, et al.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/08/05 appealing from the Office action
mailed 03/01/05.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

5,857,190	Brown	01-1999
6,067,107	Travaille et al.	05-2000
US 2003/0105845 A1	Leermakers	05-2003
5,889,954	Gessel et al.	03-1999
6,801,936	Diwan	10-2004
6,052,554	Hendricks et al.	04-2000

For Official Notice

805-7763-12	Sun Ultra 5 Service Manual	02-2000
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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-11 and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Travaille et al, Leermakers and Gessel et al. This rejection is set forth in a prior Office Action, mailed on March 1, 2005.

Claims 14-17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Travaille et al, Leermakers and Diwan. This rejection is set forth in a prior Office Action, mailed on March 1, 2005.

Claim 12 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, Travaille et al, Leermakers and Gessel et al. as applied to claim 11 and further

in view of Hendricks et al. This rejection is set forth in a prior Office Action, mailed on March 1, 2005.

(10) Response to Argument

a. Rejection under 35 U.S.C. 103(a) of claims 1-11 and 13 over Brown in view of Travaille, Leermakers and Gessel.

In response to appellant's generic statement, on page 6, that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the appellant's disclosure, as does the current rejections, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to appellant's argument on page 8 that no suggestion to combine the references was provided, it is noted that the all of the previous rejections were in fact provided with full motivation and explanation as to how and why the references would combine to form the currently claimed invention.

As indicated previously, Travaille discloses the use of a **flash memory** within a **broadcast receiver** to provide a readable/writable memory which is

capable of retaining its contents after a power loss (see Travaille at column 7, lines 4-8). Leermakers discloses a **broadcast receiver** for receiving broadcasts from a **satellite** (see Fig. 1 and paragraphs 19 and 20) which utilizes a **modem** to communicate with a **communications server** (modem bank; see Fig. 1 and paragraphs 25 and 27) to allow user specific data to be transmitted to/from the individual client and the headend (paragraph 27). Gessel discloses a communications system (Fig. 1) wherein the network manager will **encapsulate** data into **TCP/IP protocol** (column 4, lines 30-45) to allow network communications between different applications operating on different processors (column 4, lines 30-45).

In response to appellant's description of the Travaille reference on page 8, it appears that appellant has provided no actual argument against the reference, as appellant has merely provided a recitation of the abstract of the Travaille reference which is irrelevant to the specific functions and details and teachings which were relied upon.

In response to appellant's description of the Leermakers reference on pages 8 and 9, it once appears that appellant has merely provided a recitation of the abstract of the reference which is irrelevant to the specific disclosed embodiments of the reference which were actually relied upon in the current rejections.

On page 9, of the appeal brief, appellant argues that the primary purpose of Leermakers relates to downloading of software onto PDAs or the like.

In response,

- i. This is a mischaracterization of Leermakers, who discloses the much broader teachings of broadcast satellite signals being transmitted to **any** type of portable device (see Fig. 2 and paragraphs 23 and 32).
- ii. It is further noted that this argument is irrelevant to features that Leermakers is relied upon to teach. Leermakers was utilized to disclose the use of a modem for upstream communications and the benefits and uses therein. The particular type of client device transmitting those signals is irrelevant and would not alter that benefit.

On page 9, of the appeal brief, appellant argues that Leermakers does discuss or disclose any data log of transactions or navigational activity as related to the user.

In response, it is noted that Leermakers was not relied upon to disclose these features. As these features were indicated in the rejection as being taught by Brown, Leermakers was only relied upon to disclose the use of a modem for communicating upstream with a server, and the benefits and uses of this. Whether or not Leermakers utilizes a “data log of transactions or navigational activity as related to the user” is completely irrelevant to the relied upon teachings of Leermakers and his modem.

In response to appellant's arguments on page 9, in regards to the differences between Leermakers and the Brown and Travaille references, it is noted that the arguments are once again completely irrelevant to the current combination of the references. Both Brown and Leermakers two-way communications between a broadcast satellite system and a satellite receiver. Further, as Brown was silent towards how signals are transmitted upstream, Leermakers was solely relied upon for teaching the use of a modem in a satellite receiver to enable upstream communications and the well known benefits therein. The mere fact that they might download different types of software through the satellite signals has nothing to do with the relied upon teachings and benefits therein. As shown by Leermakers, a modem communicating upstream with a modem bank in a headend is a well known means for upstream communication in a broadcast satellite environment, such as utilized by Brown.

In response to appellant's arguments on pages 9 and 10, in regards to combining Leermakers with Brown and Travaille, as indicated above and in the previous rejections, it would be instantly recognizable to one of ordinary skill in the art that Leermakers and Brown's systems are both similar in nature and related. As both systems clearly utilize broadcast satellite receivers which communicate upstream with their respective headends, there is absolutely no support for the idea that the benefits introduced by Leermakers through a

common modem for upstream communication capabilities could not work in Brown's system.

Further, in regards to appellant's argument towards a supposed lack of motivation of to combine Leermakers with an "event logging system" or a "periodic reconfiguration system", it is once again noted that appellant's arguments are completely irrelevant and fail to actually address the actual rejection and the manner in which the references are actually being utilized. Leermakers was only relied upon to disclose the use of a well-known modem for upstream communication in a satellite system, and benefits therein. As the whole of Leermakers is actually **not** being combined into Brown's system, but merely the use of a modem, it is wholly unreasonable to demand Leermakers to include some sort of statement such as "I think modems are great for data logging systems", when such is completely irrelevant to Leermakers' system and un-needed when simply relying upon the desirability of a modem. Appellant's arguments seem to simply revolve around pointing to random portions of the references abstracts and then claiming that they're completely unrelated.

Finally, it is noted that appellant's characterization, on page 10, of Leermakers not teaching, discussing or suggesting the use of a broadcast receiver is completely false as a **broadcast receiver for satellite broadcasts** is the basic premise of Leermakers system (see Fig. 1 and paragraph 19).

In response to appellant's argument on page 10 that Gessel is nonanalogous art, it has been held that a prior art reference must either be in the field of appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the appellant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Gessel is directed to a communications system wherein a plurality of different systems may be interconnected to communicate with one another through use of a common protocol (TCP/IP; column 4, lines 25-45). As Brown specifically discloses a system wherein the headend event log manager will interact with a plurality of databases of information both internal and external to the headend (column 8, lines 1-34), and appellant's own specification specifically discloses encapsulating data within TCP/IP protocol to allow it to be efficiently distributed to other systems (see appellant's specification at page 15, line 35-page 16, line 14), Gessel is clearly analogous art and fully combinable with Brown as providing a means for a communication system to interact with a plurality of different types of systems and applications. Appellant's arguments as to Gessel being non-analogous art seem to revolve around the fact that Gessel simply does not disclose a plurality of other claim limitations, such as event logging, which are already taught by Brown. Gessel clearly pertains to the same communications field and further solves the same problem of interacting with disparate systems. The requirement for Gessel to further disclose a broadcast system that obtains

data regarding customer use, event logging, a transaction log as related to users and two-way interactive transmissions (which are all previously taught by Brown), would in fact simply eliminate the need for any combination as Gessel would then teach all of the claim limitations, and thus completely eliminate the need for Brown whatsoever.

In response to appellant's arguments on page 11, which once again argue that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the appellant's disclosure, as does the current rejections, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). As indicated in the previous actions and repeatedly as set forth above, the current references clearly provide full reasoning and motivation for one of ordinary skill in the art at the time of invention to combine the cited references so as to arrive at the current claimed invention.

In response to appellant's arguments on page 12, in regards to the rejection of claim 2, Brown was relied upon to disclose all of the claim limitations except those concerning encapsulation. As Gessel was already introduced in the

rejection of independent claim 1, so as to disclose the claimed encapsulation and the benefits therein, Gessel was utilized so as to reject the additional recitation of the encapsulation step of claim 2. As has already been shown above, Gessel is clearly analogous art and fully combinable with Brown as providing a means for a communication system to interact with a plurality of different types of systems and applications.

b. Rejection under 35 U.S.C. 103(a) of claims 14-17 over Brown in view of Travaille, Leermakers and Diwan.

In response to appellant's arguments on page 13, that Diwan does not relate to, teach or suggest combinations with broadcast systems, it is noted that Diwan explicitly states that the distribution system for distributing the information to subscribers includes **broadcast** techniques (see Diwan at column 5, lines 62-67). It is abundantly clear that Diwan clearly relates to broadcast systems, as he explicitly sets forth wherein broadcast distribution is utilized for information distribution.

On page 14, appellant argues claim 14 includes transactions of gaming activity, weather requests, advertising viewed and banking transactions and that no reference has been provided which discloses the other recited transactions.

In response, as indicated in the previous action, Brown was relied upon to disclose gaming activity (video games; column 4, lines 1-7), advertising viewed

(shopping services which indicates products being presented as available for purchase; column 4, lines 1-7 and lines 48-52) and banking transactions (column 4, lines 1-7 and lines 48-52). Diwan was then relied upon to disclose weather requests (see Diwan at column 3, lines 28-35).

In response to appellant's arguments on page 14, directed towards a lack of motivation for combining these "somewhat" divergent prior art references, proper motivation has been repeatedly shown in (a) above.

c. Rejection under 35 U.S.C. 103(a) of claims 14-17 over Brown in view of Travaille, Leermakers, Gessel and Hendricks.

On page 15, appellant states that "it still must be taught that this combination of these prior art references are taught and suggested from within the references themselves."

In response, In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or *in the knowledge generally available to one of ordinary skill in the art*. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Hendricks was relied

upon to teach that it was clearly known for a central facility and a local facility to communicate via satellite. One of ordinary skill in the art would clearly be aware of the obvious advantages of satellite over landline connections, such as the ability for distant locations to communicate without the need for any expensive physical infrastructure connecting them, as indicated in the rejections. As the general use of satellite, and the benefits therein, are notoriously well known in the art, and the specific use of satellite for connecting a local facility with a central facility is clearly known (as shown by Hendricks), one of ordinary skill in the art at the time of invention would indeed have been motivated to combine the references as indicated in the rejection of claim 12.

In response to appellant's arguments on page 15, directed towards the combination of Brown, Travaille, Leermakers and Gessel, proper combination and has been repeatedly shown in (a) above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

James Sheleheda
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JS


February 16, 2006

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